

REMARKS

The specification has been amended to correct minor errors. No new matter is believed to be added to the application by this Amendment.

Status of the Claims

Claims 5-14 are pending in the application.

Interview with the Examiner

The applicants thank the Examiner for graciously conducting an interview with the applicants' representative on June 21, 2004. The Interview Summary has been reviewed, and it appears to accurately reflect the substance of the interview.

Rejection Under 35 U.S.C. §103(a) Over the Applicants' Disclosure And Narui

Claims 5-14 are rejected under 35 U.S.C. §103(a) as being obvious over the Applicants' disclosure in view of Narui (*J. Crystal Growth*, 167 (1996), pp. 452-457). Applicants respectfully traverse.

The utilization of the applicants' disclosure without an admission of prior art is improper when the applicants' disclosure represents the applicants' own work. Riverwood International Corporation v. R.A. Jones & Co., Inc, 324 F.3d 1346, 66 U.S.P.Q.2d 1331 (C.A.F.C. 2003).

There is an important distinction between the situation where the inventor improves upon his own invention and the situation where he improves upon the invention of another. In the former situation, where the inventor continues to improve upon his own work product, his foundational work product should not, without a statutory basis, be treated as prior art solely because he admits knowledge of his own work. It is common sense that an inventor, regardless of an admission has knowledge of his own work. . . One's own work may not be considered prior art in the absence of a statutory basis and a patentee should not be "punished" for being as inclusive as possible and referencing his own work . . . 324 F.3d at 1355.

In the Office Action, the Examiner turns to the Background Art section of the specification and Figure 3 (which shows an undesirable defect structure, which helps to define the problem that the invention solves). However, this disclosure represents the applicants' own work which cannot be utilized to allege prior art.

As further evidence that the Background Art disclosure represents the applicants' own work, please find attached a Declaration Under 37 C.F.R. 1.132, which verifies that Background Art section at page 1, line 10 to page 2, line 4 of the specification represents the applicants' own work in accomplishing the invention. Especially, the paragraph at page 1, line 23 to page 2, line 4 describes the applicants' own work in defining the problem that the invention solves.

Also, in In re Nomiya, the C.C.P.A. determined that even if there has been an admission of prior art, this admission of prior art will still not render an

invention obvious if it points out the source of the problem that the invention solves.

It should not be necessary for this court to point out that a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is **part** of the "subject matter as a whole" which should always be considered in determining the obviousness of an invention under 35 U.S.C. 103. *In re Antonson*, 47 CCPA 740, 272 F.2d 948, 124USPQ 132; *In re Lennert*, 50 CCPA 753, 309 F.2d 498, 135 USPQ 307. The court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is, we must view the prior art without reading into that art appellant's teachings. *In re Murray*, 46 CCPA 905, 268 F.2d 226, 122 USPQ 364; *In re Sporck*, 49 CCPA 1039, 301 F.2d 686, 133 USPQ 360. The issue, then is whether the teachings of the prior art would, ***in and of themselves and without the benefits of the appellant's disclosure***, make the invention as a whole, obvious. *In re Leonor*, 55 CCPA 1198, 395 F.2d 801, 158 USPQ 20. (Emphasis in original) *In re Nomiya* 509 F.2d 566, 571, 184 U.S.P.Q. 607, 612 (C.C.P.A. 1975).

In this case there has been no admission of prior art. Even if one assumes *arguendo* that the subject matter discussed in the Background Art section and depicted in Figure 3 is prior art, this disclosure depicts the problem that the invention solves. These teachings therefore cannot be used to provide motivation to combine references.

If, as appellants claim, there is no evidence of record that a person of ordinary skill in the art that the time of the appellant's invention would have expected the problem . . . to exist at all, it is not proper to conclude that the invention which solves this problem, which is claimed as an improvement of the prior art device, would have been obvious to that hypothetical person of ordinary skill in the art. 184 U.S.P.Q. 612, 613.

There is thus no motivation to combine the secondary reference of Narui (pertaining to Al content and growth rate) with the Applicants' own disclosure. As a result, the claims are patentable because 1) the applicant's disclosure is not usable to allege prior art, and 2) there is no motivation to combine Narui even if the applicants' disclosure could be used. A *prima facie* case of obviousness has thus not been made.

This rejection is accordingly overcome and withdrawal thereof is respectfully requested.

Prior Art

The Examiner is thanked for considering the Information Disclosure Statement filed January 17, 2002, and for making the initialed PTO-1449 form of record in the application in the Office Action mailed December 20, 2002.

The prior art cited but not utilized by the Examiner shows the status of the related art that the invention supercedes. Further remarks are accordingly not necessary.

Foreign Priority

The Examiner has acknowledged foreign priority in the Office Action mailed December 20, 2002.

The Drawings

The drawing figures are found to be acceptable in the PTO-948 form dated May 7, 2002.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Robert E, Goozner, Ph.D. (Reg. No. 42,593) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$110.00 is attached hereto.

Amendment filed July 19, 2004
Response to Office Action of March 18, 2004

Appl. No. 10/046,741
Group: 2812

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By [Signature]
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Attachment(s): Declaration Under 37 C.F.R. 1.132

(Rev. 09/30/03)